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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,129	07/05/2000	Galen Rasche	LE9-00-051	4624

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EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 06/26/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,129

Applicant(s)

RASCHE ET AL.

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-13,15-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-13,15-17, and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 24, 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 24: The limitations of “the stand-alone printer is incapable of diagnosing the one or more functions without receiving the instructions” is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 25: The limitations of “ the computer is capable of writing to a display of the stand-alone printer, reading an input from a selection mechanism of the stand-alone printer, wherein a user provides the input in response to the display; reading memory associated with the stand-alone printer”; is subject matter which was not described in the specification in such a way

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as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15-17, 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Colbert et al. (U.S. Patent # 5,699,494)

Regarding claim 15: Colbert et al. teach a method for diagnosing a stand-alone printer, (abstract, column 2, lines 25-35) the method comprising the steps of: a) establishing a communication link (21, fig. 1) between the stand-alone printer and a computer; (11, fig. 1) b) receiving instructions (column 12, lines 55-65) from the computer at the stand-alone printer; and d) diagnosing (obtaining needed information from function, column 11, lines 14-15) one or more functions of the stand-alone printer in accordance with the received instructions, (column 11, lines 1-15, column 3, lines 60-68, column 4, lines 1-5), wherein the stand-alone printer is capable of processing (rasterizing the data, column 9, lines 55-60) and printing digital files, (print jobs,

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column 9, line 55) acquired by an external device, (the host that is sending the print job, column 1, lines 15-20) independent of an external host device.

Regarding claim 16: Colbert et al. teach wherein the instructions comprise content to be presented on a display of the stand-alone printer. (column 3, lines 65-67, column 4, lines 1-5, abstract)

Regarding claim 17: Colbert et al. teach the computer processing user inputs to the stand-alone printer. (Column 13, lines 15-35, column 10, lines 1-40)

Regarding claim 20: Colbert teaches presenting a menu on a display (fig. 1) of the stand-alone printer, wherein the one or more function (column 10, lines 25-35) are diagnosed after a diagnostic mode is chosen from the menu.

Regarding to claim 21: Colbert teaches wherein the computer does not process the digital files. (The character code and the picture code are decoded in the printer, not in the computer, column 3, lines 1-15)

Regarding claim 22: Colbert teaches wherein the step of diagnosing one or more functions comprising interacting with a user of the stand-alone printer to determine if the one or more functions perform correctly. (Test menu would allow a user to determine one or more functions perform correctly from the test page. For example, if the test page created has not images on it, the printer is running out of ink; a printer would inherently print no images when the printer has no ink)

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Regarding claim 23: Colbert teaches wherein the step of interacting with a user further comprise displaying on a display of the stand-alone printer a suggestion for fixing a problem diagnosed with respect to the one or more functions. (A low toner warning is a suggestion to replace the toner, column 13, lines 30-35)

Regarding claim 24: Colbert teaches the stand-alone printer is incapable of diagnosing the one or more functions without receiving the instructions. (Column 13, lines 15-35 teaches the status values are sent to the host after host indicating what reply was requested)

Regarding claim 25: Colbert teaches the computer is capable of writing to a display of the stand-alone printer, (column 4, lines 55-65) reading an input from a selection mechanism of the stand-alone printer, (column 4, lines 55-65, fig. 1) wherein a user provides the input in response to the display; (column 4, lines 15-25) reading memory (column 12, lines 1-20) associated with the stand-alone printer; and sending data to a print controller (column 7, lines 34-40) of the stand-alone printer.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-6, 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satomi (US 4,759,053) in view of Batten et al (US 6,417,937), and well known prior art.

Regarding claim 1: Satomi teaches a printer configuration, (fig. 1) comprising: a) a computer readable medium (memory 6, fig. 1, column 2, line 45) comprising data; b) a computer (host computer 4, fig. 1, column 1, line 68, column 2, line 1) having access to the data on the computer readable medium (column 3, lines 1-10); c) a communication link (modem 18, fig. 1) connected to the computer; d) a printer (terminal equipment, column 1, lines 65-69, 1, fig. 1, terminal equipment is a printer because it can print, column 3, lines 10-15) connected to the communication link (fig. 1) and in communication with the computer, (column 2, lines 64-69, column 3, line 1-10) the printer having a selection mechanism (keys 8, column 2, lines 65) and having access to the data over the communication link in response to a user's input (column 2, lines 64-69, column 3, lines 1-15) to the selection mechanism on the printer, wherein the printer comprises a printing device (control unit, column 3, line 5, and recording unit, column 3, line) capable of processing and printing digital photographs, (column 3, lines 1-15) independent of an external host device.

Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15)

Satomi does not teach the printer is a photo printer. (Print image of a photograph)

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Batten, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read photograph to the computer, and receiving the transmitted read photograph from the computer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Batten because of the following reasons: (a) using the printer to print photograph image would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Satomi as modified by Batten still does not teach the use of a digital camera to capture the digital photographs.

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However, it is well known in the art to use a digital camera to capture digital photographs. Page 1, specification of the applicant also admits that images are now captured by digital camera to be processed by a computer and be printed by a printer.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer to include: using a digital camera to capture the digital photographs.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer by the teaching of well-known prior art because of the following reasons (a) a digital camera is easy to carry; (b) it would have allowed users to capture images at the moment the user would like to capture the image; and (c) it would have created a digital image to be used by a computer.

Regarding claim 2: Satomi teaches a user interface (keyboard with a display, column 4, lines 19-21) on the photoprinter having a plurality of options selectable by a user with the selection mechanism. (Column 3, lines 35-40)

Regarding claim 3: Satomi teaches wherein the options include downloading files from the computer, (accessing and transmitting desired data from computer, column 3, lines 35-40), uploading files to the computer, (column 3, lines 50-69), or printing files (column 3, line 1-15)

Regarding claim 4: Satomi teaches wherein the one or more files (desired data, column 3, lines 35-40) are presented on the user interface. (Column 4, lines 19-23, desired data are data

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communicates from the computer to the facsimile equipment. Therefore, desired data are contents of communications)

Regarding claim 5: Satomi teaches wherein the data comprises digital (binary signals, column 2, lines 13-14) photographs. (See discussion of claim 1)

Regarding claim 6: Satomi teaches wherein the data comprises executable code (column 2, lines 15-25) for running on the photoprinter.

Regarding claim 9: Satomi teaches wherein the computer is a server. (The computer (host, column 2, lines 64-69) is responding to a command from the client (terminal equipment, column 2, lines 64-69)

Regarding claim 11: Satomi teaches a printer configuration, (fig. 1) comprising: a) a computer (host computer 4, fig. 1, column 1, line 68, column 2, line 1) having a plurality of digital (binary signals, column 2, line 13, column 2, lines 50-55) pictures on a computer readable medium (memory 6, fig. 6, column 2, line 45); b) a communication link (modem 18, fig. 1) connected to the computer; and c) a printer (terminal equipment, column 1, lines 65-69, 1 of fig. 1) connected to the computer via the communication link, the printer having means (keys 8, column 2, line 65) for accessing (column 2, lines 64-69, column 3, lines 1-15) the digital picture, wherein the printer comprises a printing device (control unit, column 3, line 5, and recording unit, column 3, line) capable of processing and printing digital photographs, (column 3, lines 1-15) independent of an external host device.

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Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15).

Satomi does not teach the printer is a photoprinter, (Print image of a photograph) and the pictures are photographs.

Batten, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read digital photograph to the computer, and receiving the transmitted read digital photograph from the computer for printing.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Batten because of the following reasons: (a) using the printer to print photograph image would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have

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simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Satomi as modified by Batten still does not teach the use of a digital camera to capture the digital photographs.

However, it is well known in the art to use a digital camera to capture digital photographs. Page 1, specification of the applicant also admits that images are now captured by digital camera to be processed by a computer and be printed by a printer.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer to include: using a digital camera to capture the digital photographs.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer by the teaching of well-known prior art because of the following reasons (a) a digital camera is easy to carry; (b) it would have allowed users to capture images at the moment the user would like to capture the image; and (c) it would have created a digital image to be used by a computer.

Regarding claim 12: Satomi teaches a method for accessing digital pictures, (column 2, lines 64-69, column 3, lines 1-15) the method comprising the steps of: a) establishing a communication link (column 3, lines 54-65) between a photoprinter and the computer; b) receiving a request (column 3, lines 35-40) at the printer from a user (the person who is entering

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command using keys, column 3, lines 35-40); and c) accessing the digital pictures (column 2, lines 64-69, column 3, lines 1-15) by the printer in response to the request, wherein the printer comprises a printing device (control unit, column 3, line 5, and recording unit, column 3, line) capable of processing and printing digital photographs, (column 3, lines 1-15) independent of an external host device.

Satomi also teaches that the terminal equipment comprises a facsimile equipment component for: reading a picture, (column 2, lines 10-16), transmitting the read picture to a computer, (column 2, lines 49-55), and receiving the transmitted read picture from the computer for printing (column 2, lines 64-69, column 3, lines 1-15)

Satomi does not teach the printer is a photoprinter, (Print image of a photograph) and the pictures are photographs.

Batten, in the same art of receiving and printing images from a printer, teaches a facsimile equipment/machine inherently print image of a photograph (column 1, lines 14-30) by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi to include: reading a photograph, transmitting the read digital photograph to the computer, and receiving the transmitted read digital photograph from the computer for printing.

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It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the facsimile equipment component of Satomi by the teaching of Batten because of the following reasons: (a) using the printer to print photograph image would have provided an extra benefit for users using the printer without adding cost to users and thereby, increased the desire of users to purchase the printer; and (b) it would have simplified the printing needs of users by providing users with a printer that would print a document as well as photograph instead of using a printer to print the document and another printer to print the photograph.

Satomi as modified by Batten still does not teach the use of a digital camera to capture the digital photographs.

However, it is well known in the art to use a digital camera to capture digital photographs. Page 1, specification of the applicant also admits that images are now captured by digital camera to be processed by a computer and be printed by a printer.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer to include: using a digital camera to capture the digital photographs.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi and Batten's printer by the teaching of well-known prior art because of the following reasons (a) a digital camera is easy to carry; (b) it would have

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allowed users to capture images at the moment the user would like to capture the image; and (c) it would have created a digital image to be used by a computer.

Regarding claim 13: Satomi teaches wherein the step of accessing comprises downloading the digital photographs (accessing and transmitting desired data from computer, column 3, lines 35-40).

7. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over as applied to claim 1 above, and further in view of Foth (US 6,473,498).

Regarding claim 7: Satomi does not teach wherein the computer is connected locally to the photoprinter.

Foth, in the same area of connecting a facsimile machine to a computer, teaches wherein a computer is connected locally to a facsimile machine by using an RS232 cable. (Column 1, lines 50-65)

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi/Batten photoprinter to include: the computer is connected locally to the facsimile machine of the photoprinter.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Satomi/Batten photoprinter by the teaching of Foth because of the following reasons: (a) it would have reduced the cost of using multiple phone lines for connecting the computers and printers in a small business environment as taught by Foth at

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column 1, lines 30-40; and (b) it would have reduced to use of phone lines as taught by Foth at column 1, lines 35-40.

Response to Arguments

8. Applicant's arguments filed 4/28/2003 have been fully considered but they are not persuasive.

With respect to applicant's argument that Colbert does not teach stand-alone printer because the printer of Colbert does not process digital files independent on a host computer, has been considered.

In reply: column 9, lines 45-60 teaches the printer would at least process the print job (digital files from the host) by rasterizing the print job without the help of a host computer.

With respect to applicant's argument that Colbert does not teach received instructions comprising content to be displayed, has been considered.

In reply: Column 10 teaches the received instruction comprising contents to be displayed such as the value being selected, column 10, line 39.

With respect to applicant's argument that column 10, Colbert does not teach process user input to the printer, has been considered.

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In reply: the user input to the push-button determines the signal being sent to the computer, and from processing the received signals, the computer then displayed according to the processed signal.

Action is Final, Necessitated by Amendment

9. Applicant's amendment necessitated the new ground of rejection presented in this office action. Therefore, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

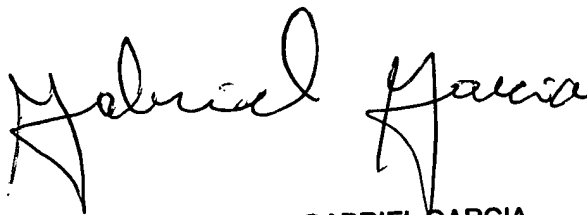
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTHS shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

June 25, 2003

A handwritten signature in black ink, appearing to read 'Gabriel Garcia'. The signature is written in a cursive, flowing style with large, connected letters.

GABRIEL GARCIA
PRIMARY EXAMINER